IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
(Attorney Docket No. 03-380-C)

In re the Application of:	
Scott A. Rosenberg et al.	
Serial No.: 10/033,401	Group Art Unit: 3622
Filed: December 26, 2001	Examiner: Jeffrey D. Carlson
For: ADVERTISEMENTS IN A TELEVISION RECORDATION SYSTEM	Confirmation No. 1472

REPLY BRIEF

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REPLY BRIEF

A. Introduction

Appellant submits this Reply Brief in response to the Examiner's Answer mailed July 20, 2010.

The Examiner's rejections of independent claims 1 and 20 are based, in part, on U.S. Patent Application Publication No. 2001/049820 (Barton) allegedly teaching "transitioning from an Index of programs TO an advertisement AND THEN from the advertisement TO the recorded program." *See*, Examiner's Answer, page 9, first paragraph, lines 6-8. The Examiner stated, "Barton fails to describe the *nature* of the transitions – are they clean cuts between the index and the ad and between the ad and the recorded program? Or are they non-clean cuts between the

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visual segments? Barton does not appear to specify." *See*, Examiner's Answer, page 9, first paragraph, lines 8-11.

The Examiner concluded that it would have been obvious to one having ordinary skill to consider any well known video transition technique in order to change from the index to the advertisement and from the advertisement to the recorded program, and since a wipe technique was an allegedly well known and previously-known technique, it would have been obvious to one of ordinary skill at the time of the invention to have used a wipe technique to transition from the index of programs to the advertising and from the advertising to the user-requested recorded program. *See*, Examiner's Answer, page 9, first paragraph, lines 11-18.

B. Argument

Appellant respectfully submits that the Examiner did not establish *prima facie* obviousness of claims 1 and 20 because, based on the teachings of Barton, it does not logically follow that a person having ordinary skill in the art at the time of Appellant's invention would have modified Barton with the Official Notice taken by the Examiner.

Barton, paragraph 0009, states *inter alia*, "It would further be advantageous to provide a method for enhancing digital video recorder television advertising viewership that allows DVR service providers to present advertisements to viewers that ***do not usurp the broadcaster's advertising space***." (Emphasis added). Appellant submits that modifying Barton to use a wipe technique to transition from the index of programs to the ***advertising*** and from the ***advertising*** to the user-requested recorded program, as stated by the Examiner, would usurp at least a portion of the broadcaster's advertising space. Since Barton teaches it is advantageous to provide a method to present advertisements that do not usurp the broadcaster's advertising space, Appellant

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submits that a person having ordinary skill in the art at the time of Appellant's invention would not have modified Barton with the Official Notice regarding a wipe technique.

Furthermore, Barton, paragraph 0012, states *inter alia*, "The invention provides a method wherein the first or last number of seconds of a commercial break are carefully authored to provide a 'teaser' to entice the viewer to watch multiple commercials during the commercial break instead of skipping the commercial break using the fast forward or jump functions of the DVR." Appellant submits that if an advertiser and/or broadcaster carefully authors the first or last number of seconds of a commercial break, it logically follows that the advertiser and/or broadcaster would not want a carefully authored portion of a commercial break to be wiped over by other content. Accordingly, Appellant submits that paragraph 0012 further supports Appellant's position that a person having ordinary skill in the art at the time of Appellant's invention would not have modified Barton with the Official Notice.

Furthermore still, Barton, paragraph 0038, states "With respect to FIG. 7, advertisers can also place the more important content in the first 702 or last 703 number of seconds of their commercials 701. This content will be able to get the desired message across to the viewer in those seconds. Given this model, content providers are able to charge advertisers a higher rate to place their commercials at the beginning or the end of a commercial break." FIG. 7 of Barton is reproduced below.

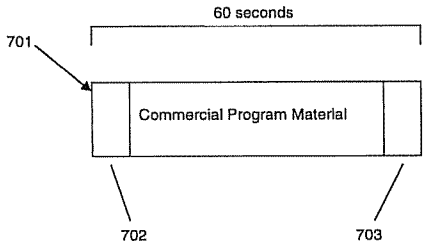

Fig. 7

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Appellant submits that since Barton teaches an advertiser can be charged a higher rate to have its commercials placed at the beginning or end of a commercial break, it logically follows that that the advertiser would not want its commercials wiped over by other content. Accordingly, Appellant submits that paragraph 0038 further supports Appellant's position that a person having ordinary skill in the art at the time of Appellant's invention would not have modified Barton with the Official Notice.

Finally, in the first paragraph of the Response to Argument section of the Examiner's Answer, the Examiner stated, "Applicant questions the examiner's explanation 'regarding the claimed feature that the advertising is displayed simultaneously with the video mode' and applicant argues that this does not appear in the claims as such. Examiner is aware of the claim language, but merely was summarizing that Barton fails to teach displaying the advertising simultaneously with either the index of programs or with the recorded programs."

Appellant respectfully submits that it does not question whether the Examiner is aware of the claim language. However, for the benefit of other Examiner's that will read the Appeal Brief (e.g., Examiners that will attend an Appeal Conference for this case) and to prevent those other Examiners from imputing additional limitations into the claims, Appellant pointed out in the Appeal Brief that the Examiner misstated language of the claims. *See*, Appeal Brief, page 8, first paragraph.

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C. Conclusion

For at least these reasons and those set forth in the Appeal Brief, Appellant maintains that the pending claims patentably distinguish over the cited art, and that the Examiner has erred in rejecting the claims. Consequently, Appellant respectfully requests reversal of the rejections and allowance of the claims.

Respectfully submitted,

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Date: September 15, 2010

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